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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,607	08/30/1999	WILLIAM M. PARROTT	008193-20001	9412

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EXAMINER

MEISLAHN, DOUGLAS J

ART UNIT	PAPER NUMBER
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2137

18

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/385,607

Applicant(s)

PARROTT, WILLIAM M.

Examiner

Douglas J. Meislahn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 22-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 17 December 2003 that amended claims 1, 9, 11, and 13 and added claims 22-27. The amendments to the claims have overcome the 112 and 102 rejections.

Response to Arguments

2. Applicant's arguments filed 17 December 2003 have been fully considered but they are not persuasive. The limitation added to the independent claims was previously in claim 10.

3. In response to applicant's arguments against the references individually (especially Jones in the top half of page 10), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jones teaches the benefit of displaying an identifier as an image so as to ease printing. In addition, a

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person of ordinary skill in the art would realize other advantages of representing identifiers as images – trademark symbols are identifier images which theoretically build brand loyalty, barcodes are identifiers that are relatively easy to read.

5. The examiner used the term “seal”, that is something that confirms, to describe Jones’ image, which is a coupon. The images on coupons are seals because they confirm values. That an image can confirm a value serves as further motivation to combine the references.

6. The new claims are supported by the sections of the specification that were kindly cited by applicant.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 8, 9, 11-13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih (6490637) in view of Jones (5500681).

In lines 18-28 of column 3, Shih describes a modem, element 22 in figures 1 and 2, that includes a serial number within a flash ROM, element 70. Serial numbers are unique identifying indicia, and so the memory anticipates the first clause of applicant's first claim. Element 100 of figure 3 states that the unique serial number is sent out. This reads on the second clause of claim 1. He does not say that the identifier is stored as an image. In lines 1-4 of column 9, Jones discusses converting an identification

number to an image format and storing the result. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store Shih's serial number as a compressed image, whereby it could be used as a seal.

With respect to claim 2, the unique serial number is needed by the modem and hence integral. Claim 3 is anticipated because data stored in a ROM, such as the serial number, is a series of bits and lines 24-28 say that the serial number is read and sent. Flash ROMs read on memory arrays and thus anticipate claim 4. Claim 11 is the physical device for the method of claim 1 and is rejected for largely the same reasons. Controller 72 is applicant's processor and executes commands from a program memory, directly RAM 76 but indirectly ROM 70. Aspects of the third clause have been shown above. The unique serial number is stored integrally because flash memory is nonvolatile. With respect to claims 8 and 12, the unique serial number is stored in ROM 70, which is the original home of the program, as detailed in lines 3-17 of column 3. Furthermore, flash memory can only be erased in blocks. As far as claims 9 and 13 are understood, this fact meets their limitations. Flash ROM is nonvolatile memory and hence meets the limitations of claim 20.

9. Claims 1, 5, 11, 14, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hall, Jr. et al. (6308281).

In the first full paragraph in column 10, Hall, Jr. et al. teach a modem that has an unique serial number burned therein. This serial number is sent from a client to a gateway. As such the first claim is anticipated. Claim 11 is rejected for largely the same reasons as claim 1. "Burned into a modem" anticipates permanently fixing the

serial number in the modem and hence claims 5 and 14. They do not say that the identifier is stored as an image. In lines 1-4 of column 9, Jones discusses converting an identification number to an image format and storing the result. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store Hall et al.'s serial number as a compressed image, whereby it could be used as a seal.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. and Jones as applied to claim 5 and further in view of Blodgett (6163489).

Hall, Jr. et al. and Jones show a modem that has a unique serial number "burned" into it. They do not say that the data is burned in by blowing fuses. In lines 19-21, Blodgett teaches storing data by blowing fuses. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the fuse-blowing memory described by Blodgett as the burned memory in Hall, Jr. et al.

11. Claims 7 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. and Jones as applied to claims 5 and 11 and further in view of Doshi et al. (6349138).

Hall, Jr. et al. and Jones show a modem that has a unique serial number "burned" into it. They do not stipulate that the unique serial number is encrypted when it is transmitted. In lines 4-7 of column 24, Doshi et al. teach encrypting a modem's serial number, thereby protecting the number from illicit viewing. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made

to encrypt the serial number that Hall, Jr. et al. transmit, as taught by Doshi et al., in order to protect the number.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih and Jones as applied to claim 11 and further in view of Doshi et al. (6349138).

Shih and Jones show a modem that has a unique serial number stored in flash ROM. They do not say that the unique serial number is encrypted when it is transmitted. In lines 4-7 of column 24, Doshi et al. teach encrypting a modem's serial number, thereby protecting the number from illicit viewing. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to encrypt the serial number that Shih transmits, as taught by Doshi et al., in order to protect the number.

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih and Jones as applied to claim 11 and further in view of Haynes (WO 97/19414) and Bhatia et al. (6118768).

Shih and Jones show a modem that has a unique serial number stored in flash ROM. They do not say that the serial number is used as an account number for a financial transaction account. In lines 18-28 of page 4, Haynes teaches a transaction identifier that reduces the risk of fraud and that includes a modem number. In lines 33-38 of column 13, Bhatia et al. display the storage of data in a modem in order to transparently user that data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the serial number in Shih to be used as an account number in order to transparently prevent fraud.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al. and Jones as applied to claim 14 and further in view of Haynes.

Hall, Jr. et al. shows a modem that has a unique serial number "burned" into it. They do not say that the serial number is used to identify an aspect of a financial transaction account. In lines 18-28 of page 4, Haynes teaches a transaction identifier that reduces the risk of fraud and that includes a modem number. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made for the serial number in Hall, Jr. et al. to be used as part of a transaction identifier in order to prevent fraud, as taught by Haynes.

15. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, Jr. et al., Jones, and Haynes as applied to claim 18 above, and further in view of Bhatia et al.

Hall, Jr. et al. and Haynes show a modem serial number that is used to identify an aspect of a transaction account. They do not say that it is the actual account number. In lines 33-38 of column 13, Bhatia et al. display the storage of data in a modem in order to transparently user that data. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store the account number in the modem, as implied by Bhatia et al., in order to provide transparent access to the system described by Hall, Jr. et al. and Haynes.

16. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih and Jones as applied to claims 9 and 20 above, and further in view of Micali (5793868).

Shih and Jones show a modem that has a unique serial number stored in flash ROM. They do not say that the serial number is compressed. In lines 10-15 of column 6, Micali teaches compressing serial numbers. This reduces the amount of space that they consume. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compress the serial number in Shih, as taught by Micali, in order to conserve memory space.

Allowable Subject Matter

17. Claims 22-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not show or suggest storing any of a credit card image, an account holder's picture, or a signature image such that the stored identifier is either unique (claim 1) or integral (claim 11) to a modem.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Scott et al. (5311596) – shows a modem with an internal digital certificate and key.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached on between 9 AM and 6 PM, Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas J. Meislahn
Examiner
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DJM